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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,640	03/29/2004	Brian L. Mueller	03051US	2381

7590 04/12/2006

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/811,640		MUELLER ET AL.	
	Examiner		Art Unit	
	Michael A. Marcheschi		1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is indefinite because it only claims a fumed silica material and not a dispersion and it is the examiners positions that the limitations “dispersed and diluted” implies a dispersion thus how can the claim only be directed to a fumed silica material, as defined in line 1 of claim 8, and not a dispersion thereof.

Claim 9 is indefinite because it depends on claim 8.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as obvious over Streinz et al. or JP-2003268354 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 1/31/06 have been fully considered but they are not persuasive.

Applicants make a statement in paragraph 3 on the first page of the remarks section that the features “dispersion and dilution” refer to the processing of the fumed silica itself and not the slurry composition in which the abrasive will be utilized. The examiner acknowledges these remarks, however the key word in the above statement is “processed”. The claims do not define

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that the abrasive is **processed** in an acetic pH solution. All the claims require is that the abrasive is “**dispersed and diluted**” in an acetic pH solution. “Dispersed and diluted” does not clearly suggest that this is how the abrasive is processed. In view of the “dispersed and diluted” limitation in the claims, the claims are defining that a fumed silica abrasive, having the defined surface area, is dispersed in an acetic pH solution. In view of this, it is apparent that the claims can be interpreted to be defining a fumed silica dispersion that is acetic. Applicants statement above is not consistent with what the claims define because the claims never used the limitation “processing”. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the first full paragraph on page 2 of the remarks section, applicants appears to be defining the process used to make the fumes silica. The examiner is aware of this, however, the instant claims are directed to a composition and not a process, thus any remarks based on the process are immaterial to the composition.

With respect to the art rejections, applicants argue that Steinz et al. has nothing to do with polishing tungsten and titanium. This argument is not persuasive because the intended use of a composition provides no weight to the composition itself. Applicants also argue the processing of the abrasive according to this reference. The examiner is aware of this and is unclear as to these arguments because, as clearly defined above, the claims do not define that the abrasive is **processed** in an acetic pH solution. All the claims require is that the abrasive is “**dispersed and diluted**” in an acetic pH solution. “Dispersed and diluted” does not clearly suggested that this is how the abrasive is processed. In view of the “dispersed and diluted” limitation in the claims,

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the claims are defining that a fumed silica abrasive, having the defined surface area, is dispersed in an acetic pH solution. Any argument based on how the abrasive is processed is not consistent with what is claimed. Applicants appear to argue that in this reference, the silica particles are dispersed in a basic solution and not an acetic solution. This is not persuasive because in column n5, lines 43-64 it is clearly implied that that fumed silica is dispersed in an acetic pH by the addition of an acid.

With respect to Keiji, applicants argue that the fumed silica is added to a basic liquid to give a basic pH. The examiner acknowledges this, however, the intermediate product, **prior** to adding to the basic liquid, is a fumed silica that is dispersed in an acetic pH liquid. In view of this, the reference clearly discloses an intermediate composition that reads on the claimed composition. In other words, although the final composition is basic, the intermediate composition used to form the final product is acetic and it is this (the intermediate composition) that reads on the instant claims. The examiner acknowledges applicants definitions in section [0011] of the specification, but these definitions do not define the “dispersed and diluted” limitations. The definitions only define the “processing” and since “processing” is not clearly defined in the claims, the definitions do not apply to the claims are written.

In summary, applicant appears to be arguing how the fumed silica is processed, however, the claims, as drafted, are not consistent with “processing” of the fumed silica but merely recite that the fumed silica is dispersed in an acidic pH solution (i.e. thus forming an acetic composition (dispersion) of fumed silica). Even if the “processing” limitation was clearly defined (which is not the case), this is a process limitation and process limitation in product by process claims do not distinguish over the art absent evident of criticality.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

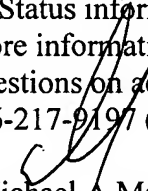
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/06
MM


Michael A Marcheschi
Primary Examiner
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